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FROM: CHRISTOPHER T. GRIFFITH
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IN RE APPLN. OF: VERSCHUEREN
APPLICATION NO. 10/530,394
FILED: APRIL 4, 2005

- ITEMS: 1. NOTICE OF APPEAL FROM THE EXAMINER TO THE BOARD OF PATENT
APPEALS AND INTERFERENCES (IN DUPLICATE) (2 PAGES); AND
2. PRE-APPEAL BRIEF REQUEST FOR REVIEW (5 PAGES)

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AUG 22 2007

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Application No. 10/530,394

Applicant: VERSCHUEREN

Filed: April 4, 2005

TC/AU: 2854

Examiner: Zimmerman, Joshua D.

Docket No.: 234854 (Client Reference No. GSGN02109)

Customer No.: 23460

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Dear Sir:

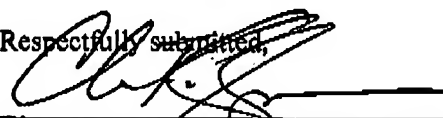
Applicants request review of the final rejection in the above-identified application.

No amendments are being filed with this request.

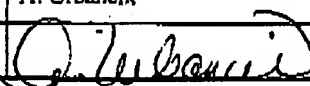
This request is being filed with a Notice of Appeal.

The review is requested for the reasons stated on the following sheets.

Respectfully submitted,


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Date: August 21, 2007

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Name (Print/Type)	A. Urbancik		
Signature		Date	August 22, 2007

Application No. 10/530,394

Pre-Appeal Brief Request for Review

Status of Application

Claims 1, 4-6, 17, 22 and 41 are finally rejected under 35 U.S.C. § 103(a) as obvious over U.S. Published Patent Application 2002/0098288 (Kamitani) in view of WO99/21715 (McCullough et al). The remaining pending claims are also rejected based on this combination. Applicants submit that the rejections are based on clear errors of fact, and that a *prima facie* case of obviousness has not been established.

Summary of Claimed Subject Matter

Claim 1 describes a method of making a heat-sensitive lithographic printing plate precursor comprising the steps of:

- (i) providing a web of a lithographic support having a hydrophilic surface;
- (ii) applying a coating comprising a phenolic resin on the hydrophilic surface of the web;
- (iii) drying the coating;
- (iv) heating the web wherein the temperature of the web is maintained above 150°C during a period of between 1 and 30 seconds; and
- (v) winding the precursor on a core or cutting the precursor into sheets.

Claim 41 includes the same limitations as included in claim 1, with the exception that step (iv) requires the temperature of the web to be maintained above 150°C during a period of between 0.1 and 60 seconds.

Reasons for Withdrawal of Rejection

Applicant respectfully submits that the analysis set forth in the Office Action fails to give appropriate weight to the clear and unambiguous temperature boundary established by the disclosure and teaching of each reference. It is respectfully submitted that these boundaries are more than simply "guides," but instead disclose and teach the existence of an upper temperature ceiling that cannot be exceeded without adversely affecting performance. There is thus no support for the obviousness rejection in the absence of hindsight.

Kamitani teaches one skilled in the art to not exceed 140°C because "when the final temperature reached in either the hot air drying device 20 or the far infrared radiation heating device 50 was 140°C or more, the developability deteriorated." When this temperature

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exceeded 145°C, the “*developing was poor.*” See Kamitani ¶ [0087] (*emphasis added*). Kamitani indicates that this teaching is supported by the data of Table 1. Table 1 of Kamitani shows that precursors having an exit surface temperature of 142°C had faults with respect to developability and overall quality, while precursors having an exit surface temperature of 153°C had *unsatisfactory developability and overall quality*. See Kamitani, Table 1 (*entries for 141°C and 152°C*)(*emphasis added*).

When a prior art reference concerning a printing plate precursor states that the developability of that precursor *deteriorates* when the plate is heated above 140°C, and was *poor* and *unsatisfactory* at or above 145°C, the teaching provided thereby is clear and unambiguous—one skilled in the art should not heat a precursor to these temperatures (and should certainly never exceed these temperatures) because the precursor will not function for its intended purpose. There is no reasonable expectation of success if one were to heat a precursor above 150°C as required by the claims. Again, the clear and unambiguous teaching of Kamitani is that a precursor should not be heated to a temperature exceeding 140°C, and certainly not in excess of 145°C. This is contrary to the pending claims.

Seeking to overcome the limitations of Kamitani, the Office Action uses McCullough et al. to allegedly teach that the time and temperature of a heating step may be varied:

[McCullough et al.] teach the desire and ability to vary, by trial and error, the time and temperature settings to achieve desired sensitivity in the printing plate precursors (page 7, lines 23-24 and lines 33-34). McCullough et al. also teach that when the printing plate precursors are heated to a higher temperature, the precursors should be held at that temperature for a shorter time (see the sentence bridging pages 7 and 8). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention, through routine experimentation, to maintain the temperature of the precursors above 150°C for a period of between 1 and 30 seconds (or for a period of between 0.1 and 60 seconds, as in claim 41) in order to achieve a desired sensitivity.

See Final Office Action, p. 3.

While the Office Action may desire to lift a portion of the alleged teaching provided by McCullough et al., it may only do so if the portion does not distort the teaching of the reference as a whole. Indeed, it is well established that a reference must be considered for all that it teaches. In this case, even if one assumes that McCullough et al. teaches one skilled in

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the art to vary the time and temperature during heating, the boundaries taught by that very same reference (as well as those taught by Kamitani) preclude it from teaching the invention as claimed which requires *inter alia* heating the web wherein the temperature of the web is maintained above 150°C during a period of between 1 and 30 seconds. *See claim 1.*

Specifically, and as noted herein above, Kamitani unambiguously teaches that heating at a temperature of 140°C creates undesirable problems in the final product, while heating at 145°C provides an unsatisfactory product. Thus, even if one were to accept the proposition that McCullough et al. teaches one to vary the temperature of Kamitani, one skilled in the art would never vary the temperature above 140°C (and certainly not over 145°C) because Kamitani teaches that an unsatisfactory product will result. Indeed, one skilled in the art would be taught by the combination to vary the temperature below 140°C where acceptable results would be obtained. Thus, the alleged combination with McCullough et al. would not yield the claimed invention.

For at least these reasons, Applicant submits that all of the pending claims are allowable over the prior art of record.

Further, and in connection with the timing aspect of precursor heating as recited in the claims, it is clear that McCullough et al. teaches that a *minimum of four (4) hours of treatment must be used in all cases:*

The time for the heat treatment can also be determined by trial and error. Generally, the lower the temperature for the heat treatment, the longer the time should be. *In all cases however we favor carrying out the heat treatment for at least 4 hours; and preferably for at least 24 hours and most preferably for at least 48 hours, especially in the case of the lower temperatures.*

See McCullough et al., pp. 7-8 (emphasis added). The lowest heating time taught by McCullough et al. is, therefore, *4 hours "in all cases."* Thus, the plain language of McCullough et al. teaches that any variation in the time of heating should range between 4 and 48 hours. This is markedly different than the heating time recited in the claims, which is in the minute range. McCullough et al. thus fails to teach the claimed invention.

Moreover, and with regard to temperature, McCullough et al. teaches that the temperature of its precursor (after cutting into sheets) *should not exceed 90°C*, with 50°C-

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60°C being the most favored. There is no basis other than hindsight to conclude that McCullough et al. would in any way suggest that the precursor temperature be heated above 90°C, let alone above 150°C as required by the claims—an increase of 66% over the maximum disclosed temperature of 90°C. *See McCullough et al., p. 7 (emphasis added).*

Thus, even if the references are combined, the inventive method would not be provided, the claimed methods including, *inter alia*, the heating conditions required by step (iv). Instead, Kamitani clearly and unambiguously teaches one skilled in the art to *not* heat the precursor to above 150°C (as claimed), and indeed teaches that temperatures less than 140°C must be used in order to avoid problems with developability that arise when the precursor is heated to a temperature of above 140°C. This upper limit on temperature taught by Kamitani is a hard boundary that, according to the teaching of this reference, cannot be exceeded without providing an inferior product. Clearly, one skilled in the art would not have a reasonable expectation of success if following the approach suggested in the Office Action. Moreover, Kamitani fails to teach the timing aspect of the claimed method.

McCullough et al. also fails to teach one skilled in the art to exceed the temperature limit set by Kamitani, or to limit the heating time to that which falls within the claimed range. McCullough et al. favors an upper limit of 90°C on precursor temperature, but at the same time prefers a 50°C-60°C temperature. Indeed, the temperatures referenced in the McCullough et al. examples support this teaching. It should be further appreciated that, unlike the claimed method, the temperatures in the McCullough et al. examples do not refer to a precursor temperature, but instead to the temperature of the "hotbox oven." For example, Example 2 uses a hotbox oven at 110°C and 140°C for certain time periods, but provides no information as to the temperature of the precursor *per se*. *See McCullough et al., Example 2.*

Further, McCullough et al. teaches that "*[i]n all cases however we favor carrying out the heat treatment for at least 4 hours . . .*". *See McCullough et al., pp. 7-8 (emphasis added).* Absent hindsight, this cannot be rationalized to include the claimed time period which ranges in the minutes—indeed the reference teaches what it says—shortening the heating period from several hours to minutes simply cannot be found to be taught by this passage. To assert otherwise is a conclusion driven by solely hindsight. Withdrawal of the rejections of all pending claims based on Kamitani and McCullough et al. is requested.